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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,618	10/17/2003	Masanori Shinozaki	12844.0048US01	2442

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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/688,618

**Applicant(s)**

SHINOZAKI, MASANORI

**Examiner**

Kuo-Liang Peng

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.  
5) ☒ Claim(s) 5-8, 10 and 12 is/are allowed.  
6) ☒ Claim(s) 1-3, 9, 11 and 15 is/are rejected.  
7) ☒ Claim(s) 4 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Applicants' amendment filed on June 6, 2006 is acknowledged. Claims 13-14 are withdrawn. Claim 15 is added. Now, Claims 1-15 are pending.
2. The instant Office action is made non-final because of a newly discovered reference, Hjokkirigawa548 (US 2002/0114548). Examiner apologizes for causing any inconvenience.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 9, it is not clear as to whether Applicants intend to claim a composition or an article.

In Claim 11, it is not clear as to whether Applicants intend to claim a composition or a coating process.

***Claim Rejections - 35 USC § 103***

6. Rejection of Claims 1-2, 9 and 11 under 35 USC 102(b) as being anticipated by Hirikirigawa (JP 2002-235016) and Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Hirikirigawa are maintained because the rejection is adequately set forth in paragraphs 5 and 7 of Paper No. 030406. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 4, 4<sup>th</sup> paragraph), arguing that Hirikirigawa's material does not result in a film on the tile appears to be not persuasive because "capable of coating and drying" and "capable of forming a dry film by coating and drying thereof" are merely intended use. Certainly, Hirikirigawa's material has the same capabilities because it reads on Applicants' claimed material.

For Applicants' argument (Remarks, page 5, 1<sup>st</sup> paragraph), Applicants are reminded that "lubricant" in the preamble is merely an intended use, and does not carry any weight of patentability. Furthermore, the frictional resistance is a relative

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term. It is not clear as to how poor the lubricity of a material is in order to be considered as a frictional resistant material. Especially, the “frictional resistance” cited in Hirikirigawa ([0003]) refers to a wet surface, and does not necessarily apply to a dry surface.

***Claim Rejections - 35 USC § 102***

7. Claims 1-3, 9, 11 and 15 are rejected under 35 USC 102(b) as being anticipated by Hirikirigawa548 (US 2002/0114548).

Hirikirigawa548 discloses a lubricant comprising a liquid thermosetting resin and a rice bran ceramics. ([0009]-[0019] and Examples) Applicants are reminded that “lubricant” in the preamble is merely an intended use, and does not carry any weight of patentability. The phrases “capable of coating and drying” and “capable of forming a dry film by coating and drying thereof” are merely intended use. In other words, the instant claims are directly to a composition.

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the above teaches or fairly suggests the use of a liquid acrylsilicone resin.

*Allowable Subject Matter*

9. Claims 5-8, 10 and 12 are allowed.

10. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest reference: The above references do not teach or fairly suggest the sliding member having a **dry film** set forth in the instant claims.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
August 15, 2006

  
Kuo-Liang Peng  
Primary Examiner  
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